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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 10/022,165 | 12/17/2001 | Michael Wayne Brown | AUS920010844US1 | 3985 |
| 43307 | 7590 | 10/05/2005 | EXAMINER | |
| IBM CORP (AP) C/O AMY PATTILLO P. O. BOX 161327 AUSTIN, TX 78716 | | | TIEU, BINH KIEN | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 2643 | |

DATE MAILED: 10/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|-----------------|--------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 10/022,165 | BROWN ET AL. | |
| | Examiner | Art Unit | |
| | BINH K. TIEU | 2643 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 August 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-42 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-42 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date. _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. The Amendment filed on 08/19/2005 was entered. Applicant canceled claims 43-59 and selected group I including claims 1-42 with traverse. As the results, claims 1-42 are pending in this application at this point.

Election/Restrictions

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-36, drawn to a method and a system for predicting fraudulent identification usage in a telephone network, classified in class 379, subclass 145.
- II. Claims 37-42, drawn to protecting credit card fraud, classified in class 235, subclass 380.

3. Inventions I and II are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because Invention I is directly drawn to a method and a system for predicting fraudulent identification usage in a telephone network. The subcombination has separate utility such as protection fraud in either a telephone network, a credit card system or others.

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4. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement is traversed (37 CFR 1.143). Applicant is also reminded to cancel claims included the non-elected invention.

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Response to the Applicant's election with traverse

6. Applicant's election with traverse of group I including claims 1-42 in the remarks in the reply filed on 08/19/2005 is acknowledged. The traversal is on the ground(s) that claim 37 recited ***the same elements*** that are common with claims 1 and 19. This is not found persuasive because of the followings.

In response to the Applicant's argument on page 17 of the above mentioned amendment wherein the Applicant stated as following:

"...In contrast, Applicants respectfully assert that the same elements that are common between claims between claims 1 and 19 are also common in claim 37 and therefore the relationship between claims is such that claim 37 constitutes the essential distinguishing feature of the Group I combination..."

The Examiner respectfully disagrees with the Applicants' arguments above. A basic restriction between two different groups of claims is based on limitations recited in at least two

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different sets of claims including both independent claim and *its dependent claim or claims*.

Applicants should consider all claims in the group or groups or in the specific set of claims, not among independent claims alone. In this case, sets of claims 1-8 and 19-36 wherein at least claims 1 and 5-6 of and claims 19 and 23-24 in the sets of claims of group I recited the same elements as common (predicting fraudulent identification usage in a *telephone network*) between claims while set of claims 37-42 does not. None of claims 37-42 recited the feature of a *telephone network*.

Therefore, it is clearly to conclude that set of claims 37-42 is a subcombination and drawn to a fraud detection product which may be applied to either a credit card system, a telephone network, or the like while the sets of claims 1-18 and 19-36 are combination having the same elements of a fraud detection product with a *telephone network*.

The requirement is still deemed proper and is therefore made FINAL.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Binh K. Tieu whose telephone number is (571) 272-7510 and E-mail address: BINH.TIEU@USPTO.GOV.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Curtis Kuntz, can be reached on (571) 272-7499 and **IF PAPER HAS BEEN MISSED FROM THIS OFFICIAL ACTION PACKAGE, PLEASE CALL Customer Service at (703) 306-0377 FOR THE SUBSTITUTIONS OR COPIES.**

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BINH TIEU
PRIMARY EXAMINER

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Date: September 29, 2005